

## **REMARKS**

By this Amendment, the Specification has been amended. No new matter has been introduced by this Amendment.

In the outstanding Office Action, the specification was objected to for containing legal phraseology; claims 1-4, 9, 12-14, 17 and 49 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,168,691 to Errani ("Errani"); claims 24, 25, 27, 30, 34, 50-52 and 54 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,204,377 to Lancaster et al. ("Lancaster"); claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Errani in view of Lancaster; and claims 31-33 and 58 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lancaster in view of Errani. Claims 18-23, 36-48, and 57 were allowed; and claims 5-8, 11, 15, 16, 26, 28, 29, 35, 53, 55, and 56 were indicated as containing allowable subject matter.

With regard to the objection to the specification, the Abstract has been amended and no longer includes the term "means." In view of this amendment, Applicants respectfully request that the outstanding objection to the specification be withdrawn.

Applicants respectfully traverse the rejection of claims 1-4, 9, 12-14, 17, and 49 as anticipated by Errani. Errani fails to disclose or suggest all of the features of independent claim 1. Errani discloses an automatic plastic film wrapping machine particularly suitable for suitcases (65). The machine includes plastic film (6) which is grasped by a gripper (5). When the suitcase is placed on a turntable (2), the front side of the suitcase rests against the gripper (5), while the lateral sides of the suitcase are positioned between a fixed locating element (3) and a mobile locating element (4).

(Column 3, Lines 40-50). As shown in FIGS. 2, 9a, and 9b, the gripper (5) holds the leading end of plastic film adjacent to the front side of the suitcase (65), which is located at a distance away from the fixed locating element (3). Errani fails to disclose or suggest that the leading end of plastic film be secured to the fixed locating element (3), as required by independent claim 1.

Furthermore, the MPEP recites, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," and, "the identical invention must be shown in as complete detail as is contained in the ... claim." (MPEP 2131). As explained in the preceding paragraph, Errani fails to disclose or suggest all of the elements of independent claim 1, and thus cannot anticipate independent claim 1.

If the Examiner is basing the 102 rejection on inherency, such an argument has not been provided. Regardless, an argument based on inherency would also fail to cure the deficiencies in Errani. The MPEP recites, "the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic," and, "to establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" (MPEP 2112). The extrinsic evidence in Errani does not make clear that that the leading end of plastic film be secured to the fixed locating element (3), because the leading end could hit the front of the suitcase (65) and not the

fixed locating element (3). Thus, Errani does not make clear that the missing descriptive matter is present, and so the burden to establish inherency has not been met.

Accordingly, for at least the above reasons, Errani does not disclose or suggest the invention as set forth in independent claim 1, and therefore cannot anticipate claim 1 or the claims that depend therefrom.

Errani also fails to disclose or suggest all of the features of independent claim 49. In Errani, the suitcase (65) rests upon a surface on the turntable (2). As shown in FIG. 9b, the surface extends to the gripper (5). The fixed locating element (3) is not positioned between a film clamp and a load support surface, as required by independent claim 49. Instead, Errani discloses a turntable surface positioned between the gripper (5) and the fixed locating element (3). Thus, Errani does not disclose or suggest positioning the fixed locating element (3) between a film clamp and a load support surface, as suggested by the Examiner. Indeed, the purpose of the fixed locating element (3) is to support a lateral side of the suitcase (65), a purpose that could not be achieved if the fixed locating element (3) were positioned as required by claim 49. Accordingly, for at least the above reasons, Errani does not disclose or suggest the invention as claimed in independent claim 49. Reconsideration is requested.

Claims 24, 25, 27, 30, 34, 50-52, and 54 were rejected as being anticipated by Lancaster. Applicants respectfully traverse this rejection.

Lancaster fails to disclose or suggest all of the features of independent claims 24 and 50. Each of independent claims 24 and 50 requires a "fixed wrapping structure." Lancaster discloses a process and apparatus for wrapping netting material around a

load. The apparatus includes movable turntable clamps (124), configured to rotate upwardly from beneath the surface of a turntable to a position above the turntable. (Column 7, Lines 32-34). Therefore, element (124) is not a "fixed wrapping structure," as asserted by the Examiner, but is a pair of movable clamps. Movement of the turntable clamps (124) is necessary to permit holding and release of the packaging material, as disclosed in Lancaster. Accordingly, for at least the above reasons, Lancaster cannot anticipate independent claims 24 and 50, or the dependent claims that depend therefrom.

Claim 10 was rejected as being unpatentable over Errani in view of Lancaster. Claim 10 depends from independent claim 1. As discussed above with regard to claim 1, Errani does not disclose or suggest "securing a portion of the leading end of the film web to a fixed wrapping structure prior to releasing the leading end of the film," as required by claim 1. Lancaster does not remedy this deficiency of Errani. For at least this reason, neither Errani nor Lancaster, alone or in combination, renders claim 10 obvious. Reconsideration is requested.

Claims 31-33 and 58 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lancaster in view of Errani. Claims 31-33 depend directly or indirectly from independent claim 24. As discussed above with regard to claim 24, Lancaster does not disclose or suggest use of a fixed wrapping structure. The clamps 124 are movable structures and to render them fixed, as suggested by the Examiner, would destroy the invention of Lancaster. Thus, there is no motivation to modify Lancaster with Errani as suggested by the Examiner. Further, even if such a modification were made, the invention as claimed would not result. As discussed

above, Errani does not disclose or suggest “securing a portion of a leading end of the film web to the fixed wrapping structure.” Reconsideration is requested.

With regard to independent claim 58, Lancaster fails to disclose a fixed wrapping structure. Additionally, Lancaster fails to disclose or suggest securing a portion of the leading end of the film web to the fixed wrapping structure prior to releasing the leading end of the film, as required by independent claim 58. The Examiner acknowledges the deficiencies in Lancaster on page 5 of the outstanding Office Action, and overcomes the deficiency by stating, “the Errani reference discloses that is old and well known in the art to provide a fixed wrapping structure (3), and that it is old and well known to secure a portion of the leading end of the film web to a portion of the fixed wrapping structure prior to releasing the leading end of the web.” Applicants respectfully disagree. As previously explained in regard to independent claim 1, Errani fails to disclose or suggest securing a portion of the leading end of the film web to a portion of the fixed wrapping structure (3). To overwrap the clamp 124 of Lancaster as suggested by the Examiner would destroy the function of the clamps 124. Alternatively, modifying Lancaster to incorporate a fixed locating element (3) of Errani is not feasible because the addition of a fixed locating element would block the load (100) from sliding horizontally onto and off of turntable (108). Accordingly, for at least the above reasons, Lancaster in view of Errani does not disclose or suggest the elements recited in independent claim 58.

Claims 2-17, 25-35, and 51-56 all depend from one of independent claims 1, 24, 49, 50, and 58, and are therefore allowable for at least the same reasons stated above that independent claims 1, 24, 49, 50, and 58 are allowable. In addition, at least some

of the dependent claims recite unique combinations that are neither taught nor suggested by the cited art, and therefore some are also separately patentable.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

In discussing the specification, claims, abstract, and drawings in these Remarks, it is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and/or shown in the drawings. Rather, Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

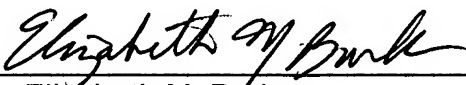
The Examiner is invited to contact the undersigned at (202) 408-4488 if the Examiner believes that a discussion would further the prosecution of the application.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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